

## **REMARKS**

### **Claim Rejections**

Under 35 U.S.C. §102, claims 1-2, 5-7, and 10-11 are rejected as allegedly being anticipated by Son (U.S. 2005/0197169 A1); claims 14-15 are rejected as allegedly being anticipated by Seita (US 6,973,327 B2); and claims 18-19 are rejected as allegedly being anticipated by Engstrom et al. (U.S. 2003/0017848 A1).

Under 35 U.S.C. § 103(a), claims 3, 8 and 12 are rejected as allegedly being unpatentable over Son in view of Arisawa et al. (U.S. 2003/0141989 A1); claim 16 is rejected as allegedly being unpatentable over Seita in view of Arisawa et al.; claim 20 is rejected as allegedly being unpatentable over Engstrom et al. in view of Arisawa et al.; claims 4, 9, and 13 are rejected as allegedly being unpatentable over Son in view of Bashan et al. (U.S. 6,719,206 B1); claim 17 is rejected as allegedly being unpatentable over Seita in view of Bashan et al.; claim 21 is rejected as allegedly being unpatentable over Engstrom et al. in view of Bashan et al.; and claim 22 is rejected as allegedly being unpatentable over Engstrom et al. in view of JP 2004348497 A.

### **Drawings**

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicants assume that the drawings are acceptable as filed.

### **Claim Amendments and New Claims**

By this Amendment, Applicants have canceled claims 4, 9, 13, 17, and 22 and at least some of their substantive features are incorporated into, respectively, independent claims 1, 5, 10, 14, and 18. Consequently, Applicants respectfully submit that the rejections under 35 U.S.C. §102 should be withdrawn.

In addition, other amendments have been made for clarification. These other amendments do not narrow the scope of the claims.

With respect to the obvious rejections based on Son in view of Bashan

et al., Applicants respectfully submit that Bashan et al. do not cure the deficiencies in Son. Particularly, Bashan et al. disclose a substrate 11 that is a Printed Circuit Board (PCB) onto which the coil antenna 40 may be etched in a known manner, or by other means, such as deposition or wires. See, e.g., column 4, lines 53-65. However, Bashan et al. fail to teach or suggest an antenna comprising a printed circuit board or a coiled enameled wire. Rather, Bashan et al. teach that an antenna is etched on a Printed Circuit Board. Similarly, Bashan et al. fail to cure the deficiencies in Seita, with respect to the obvious rejections based on Seita in view of Bashan et al.

With respect to Engstrom et al. in view of JP 2004348497 A, Applicants respectfully submit that JP 2004348497 A was published December 2004. The present application was filed February 2004. Consequently, JP 2004348497 A is not prior art with respect to the present application, and the rejection based on the citation of this reference should be withdrawn.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicants' disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed. Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed. Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Additionally, the cited references do not teach or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicants' claimed structure. Applicants hereby respectfully submit that no combination of the cited prior art renders obvious Applicants' claims.

With respect to the teachings of the other references, Engstrom et al. and Arisawa et al., because they do not cure the basic deficiencies of the other references, their combination with the other prior art would not supply

the missing teachings to render the claims obvious. So as not to burden the record further, Applicants will not discuss each of the aforesaid secondary references in detail except to state that Applicants do not necessarily acquiesce to any of the statements in the office action referring to such secondary references and reserve the right to comment later regarding same, if ever necessary.


**Summary**

In view of the foregoing amendments and remarks, Applicants submit that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicants' local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: March 15, 2006

By:



Bruce H. Troxell  
Reg. No. 26,592

TROXELL LAW OFFICE PLLC  
5205 Leesburg Pike, Suite 1404  
Falls Church, Virginia 22041  
Telephone: 703 575-2711  
Telefax: 703 575-2707